IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)
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Donald E. Smith	) Group Art Unit: 3629
	)
Application No.: 10/700,028	) Examiner: Ouellette, Jonathan P.
	)
Filed: November 3, 2003	)
	)
For: METHOD AND SYSTEM FOR	)
PROVIDING A COMMUNITY	)
OF INTEREST SERVICE	)

Mail Stop: APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SECOND APPEAL BRIEF

Sir:

This Appeal Brief is filed under Rule 41.37, appealing the final decision of the Examiner

dated June 9, 2010 and is further responsive to the Advisory Action dated August 18, 2010. A

Notice of Appeal was filed on September 3, 2010. Each of the topics required by Rule 41.37 is

presented herewith and labeled in accordance therewith. Only one copy of this Appeal Brief is

required, in accordance with MPEP §1205.02.

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I. REAL PARTY IN INTEREST

The real party in interest of the present application, solely for purposes of identifying and avoiding potential conflicts of interest by board members due to working in matters in which the member has a financial interest, is Verizon Communications Inc. and its subsidiary companies, which currently include Verizon Business Global, LLC (formerly MCI, LLC) and Cellco Partnership (doing business as Verizon Wireless, and which includes as a minority partner affiliates of Vodafone Group Plc). Verizon Communications Inc. or one of its subsidiary companies is an assignee of record of the present application.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application of which the

Appellant is aware.

III. STATUS OF CLAIMS

Claims 1-7 and 9-18 were pending in the application prior to the filing of this appeal brief and all stand finally rejected. Claim 8 had been previously canceled without prejudice or disclaimer. Claim 16, intended to be canceled by Applicant (hereinafter "Appellant") by action taken without prejudice or disclaimer in an August 3, 2010 amendment after final, which was not entered by the Examiner, is hereby canceled without prejudice or disclaimer.

Therefore, claims 1-7, 9-15 and 17-18 are currently pending and are the subjects of this appeal.

IV: STATUS OF AMENDMENTS

Subsequent to the final Office Action of June 9, 2010, (hereinafter "final Office Action"), Appellant filed an after-final Reply under 37 C.F.R. §1.116 on August 3, 2010 but did not amend the claims, except for attempting to cancel claim 16. That after final reply was not entered as indicated in the August 18, 2010 Advisory Action. Accordingly, there are no outstanding amendments in this application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary of the presently claimed subject matter indicates that certain portions of the specification (including the drawings) provide examples of embodiments of elements of the claimed subject matter. It is to be understood that other portions of the specification not cited herein may also provide examples of embodiments of elements of the claimed subject matter. It is also to be understood that the indicated examples are merely examples, and the scope of the claimed subject matter includes alternative embodiments and equivalents thereof. References herein to the specification are thus intended to be exemplary and not limiting. Appellant maps all pending independent claims[1] to the drawings and/or Specification, as follows:

Independent claim 1 recites a computer-implemented method for connecting no more than a plurality of customers, (e.g., 106A, B, C, D in Fig. 1) using a domain accessible through a communications network (e.g., 120 in Fig. 1), each of said plurality having a billing address and an account associated with a service provider (e.g., telco 100 in Fig. 1), said service provider communicatively linked to said domain, said method comprising:

notifying said each of said plurality about said domain by including information in a billing statement for said each of said plurality; (e.g., 202, 204, 206 in Fig. 2 and at least Specification ¶'s [0029] and [0030] and [0040])

providing said each of said plurality with access to said domain; (e.g., 208 in Fig. 2, 302 & 304 in Fig. 3 and at least Specification ¶'s [0030] - [0032] and [0040])

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[1] All dependent claims stand or fall with their respective independent claims.

providing said each of said plurality with a customer profile questionnaire; (e.g., 306 in

Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of

customers; (e.g., 308 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving an inquiry about a community of interest (COI) from one customer in said

portion; (e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

determining existence of said COI with which other customers in said portion are

associated; (e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

sending by operation of said computer a generated status message to only said other

customers, if said COI exists, as confirmation that said one customer has joined said COI; (e.g.,

412 in Fig. 4 and at least Specification ¶'s [0034] and [0040])and

allowing at least a subset of said portion of said plurality of customers giving common

answers to said questionnaire, to communicate with each other using said domain while not

disclosing true identity of each customer of said subset to others of said plurality, said subset

comprising said one customer and said other customers. (e.g., 414 in Fig. 4 and at least

Specification ¶'s [0034] and [0040])

Independent claim 9 recites a system for allowing no more than a plurality of customers

(e.g., 106A, B, C, D in Fig. 1) to communicate over a network (e.g., 120 in Fig. 1), said system

comprising:

a service provider (e.g., telco 100 in Fig. 1 and at least Specification ¶ [0024]) having an

account (e.g., at least Specification ¶'s [0025] - [0026]) with each of said plurality;

a domain associated with said service provider; (e.g., 208 in Fig. 2 and at least

Specification ¶'s [0030] - [0031] and [0040])

billing means controlled by said service provider for invoicing each said account; (e.g.,

202 in Fig. 2 and at least Specification ¶'s [0029] - [0030] and [0040])

notification means associated with said billing means for informing said each of said

plurality about said domain and for providing said each of said plurality with a customer profile

questionnaire; (e.g., 202 in Fig. 2 and at least Specification ¶'s [0029] - [0030] and [0040])

means for receiving responses to said questionnaire (e.g., 306, 308, 310 in Fig. 3 and at

least Specification ¶'s [0032] and [0040]) from at least a portion of said plurality and for

allowing at least a subset of said portion of said plurality giving common answers to said

questionnaire to communicate with each other (e.g., 414 in Fig. 4 and at least Specification ¶

[0034] and [0040]) using said domain, wherein said receiving and allowing means includes

means for receiving an inquiry (e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and

[0040]) about a community of interest (COI) from one customer of said subset, means for

determining existence of said COI with other customers of said subset belonging to said COI,

(e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) and means for sending a

generated status message (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) to

only said other customers as confirmation that said one customer has joined said COI; and

a server associated with said domain for allowing said each of said subset to access said

domain upon authentication. (e.g., 102 in Fig. 1 and at least Specification ¶ [0024]; and e.g., Fig.

6 and at least Specification ¶'s [0036] - [0040]).

Independent claim 11 recites a computer-readable medium (e.g., 604, 606, 608 in Fig. 6

and at least Specification ¶ [0037]) containing a plurality of instructions that, when executed by

at least one processor, (e.g., 602 in Fig. 6 and at least Specification ¶'s [0036] - [0037] and

[0040]) causes said at least one processor to perform a method for inter-connecting through a

communications network (e.g., 120 in Fig. 1) no more than a plurality of customers (e.g., 106A,

B, C, D in Fig. 1) who are associated with a service provider (e.g., telco 100 in Fig. 1 and at least

Specification ¶ [0024]), said method comprising:

providing each of said plurality of customers with a customer profile questionnaire; (e.g.,

306 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of

customers; (e.g., 308 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

allowing a subset of said portion of said plurality of customers giving common answers

to said questionnaire to have access to a domain associated with said service provider; (e.g., 414

in Fig. 4 and at least Specification ¶'s [0034] and [0040])

accepting data from at least one of said subset of said portion of said plurality of

customers, (e.g., 504-514 in Fig. 5 and at least Specification ¶'s [0035] and [0040])

verifying a true identity of said at least one of said subset of said portion of said plurality

of customers based upon at least a portion of said data; (e.g., 504 in Fig. 5 and at least

Specification ¶'s [0035] and [0040])

mapping said true identity to an alias associated with said at least one of said subset of

said portion of said plurality of customers; (e.g., 512 in Fig. 5; 410 in Fig. 4; and at least

Specification ¶'s [0034] - [0035] and [0040])and

allowing others of said subset of said portion of said plurality of customers with access to

said domain to have access only to said alias while keeping said true identity in confidence; (e.g.,

410, 412, 414 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

wherein said at least one customer of said subset inquires about a community of interest

(COI) (e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040]), said COI is

determined to exist with certain customers of said subset belonging to said COI, (e.g., 406 in Fig.

4 and at least Specification ¶'s [0034] and [0040]) and a status message is generated and sent to only said certain customers as confirmation that said at least one inquiring customer has joined said COI (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]).

Independent claim 17 recites a computer-implemented method for enabling each customer in a plurality of customers of a service provider to determine if other customers in said plurality have one or more interests in common with said each customer and to anonymously communicate over a network with certain of said other customers having said interests in common, said method comprising:

notifying said each customer by way of its respective billing statement from said service provider about a common domain in said network over which anonymous communication may take place and providing said each customer with a customer profile questionnaire; (e.g., 202, 204, 206 in Fig. 2 and at least Specification ¶'s [0029] - [0031] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of customers; (e.g., 306, 308 in Fig. 3 and at least Specification ¶'s [0032] - [0033] and [0040])

providing a subset of said portion of said plurality of customers giving common answers to said questionnaire with access to said domain (e.g., 314 in Fig. 3 and at least Specification ¶'s [0032] - [0033] and [0040]) and giving each in said subset access to information about said interests of said other customers (e.g., 404 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) in said subset to permit said anonymous communication between said each customer in said subset and said other customers in said subset, said anonymous communication resulting from aliases (e.g., 512 in Fig. 5 and at least Specification ¶'s [0035] and [0040]) each generated randomly by a server (e.g., 102 in Fig. 1 and 600 in Fig. 6 and at least Specification ¶'s [0036] - [0040])for, respectively, a different one of said subset of customers, whereby said each customer

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in said subset knows said aliases and not true identities of said other customers in said subset;

permitting each in said subset to inquire about a respective community of interest (COI); (e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

determining existence or non-existence of said COI; (e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

sending, by operation of said computer if said COI exists, a generated status message only to others of said subset who belong to said COI as confirmation that said inquiring customer has joined said COI; (e.g., 410, 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) and

sending, by operation of said computer, if said COI does not exist, a different generated status message to said inquiring customer signifying that said inquiring customer has successfully joined a new COI. (e.g., 408, 410, 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

In the final Office Action, the following three rejections were made, and these three grounds of rejection are to be reviewed on appeal: [2]

Ground of Rejection Number One:

Claims 1-7, 9, 12, and 18 are rejected under 35 U.S.C. §103(a) as being un-patentable over Burnstein et al. (U.S. 2002/0032735 A1; hereinafter "Burnstein") in view of Munsil et al. (U.S. Patent 5,761,650; hereinafter, "Munsil") and further in view of Quach (U.S. 2004/0080534 A1; hereinafter "Quach"), and further in view of Official Notice. (Office Action, pg 3, ¶8)

Ground of Rejection Number Two:

Claims 11 and 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burnstein in view of Quach, (Office Action, pg 7, ¶25) and further in view of Official Notice (Office Action, pg 9, ¶28).

Ground of Rejection Number Three:

Claims 10 and 17 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Burnstein in view of Munsil in view of Quach, and further in view of Carter et al., (U.S. 2005/0068983 A1; hereinafter "Carter"), (Office Action, pg 10, ¶33) and further in view of Official Notice (Office Action, pg 13, ¶43).

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[2] The final Office Action also issued a section 112 rejection of certain claims but that rejection was withdrawn as reported in the 8/18/2010 Advisory Action; the final Office Action also issued a section 103 rejection of claim 16 but that claim is canceled herein; accordingly these rejections are moot and not to be reviewed on appeal. Further, as noted in the Argument section which follows, Appellant's dependent claims shall stand or fall with their independent claims. Substantive arguments are presented for independent claims 1, 9, 11 and 17.

VII: ARGUMENT

The independent claims on appeal are claims 1, 9, 11, and 17. Appellant shall let the dependent claims stand or fall with their respective independent claims. Therefore, the only claims for which substantive argument is presented are claims 1, 9, 11 and 17.

A. SUMMARY OF THE BURNSTEIN DISCLOSURE:

Burnstein teaches apparatus, means and methods for automatic community formation for phones and computer networks. (Title) Burnstein determines commonality of subject matter based on subject matter searched by different individuals. Burnstein discloses an automatic telephone, Internet or intranet community formation system that utilizes spoken words or matching search terms. The invention utilizes wireless and wired voice communications, database and list server technology to archive and match users based upon their search terms entered into a telephone system or a search engine, Internet, intranet, extranet, local area network, wide area networked, wired, wireless or standalone computer. A community formation system refers to a means of inviting one or more persons to communicate via voice, email or other method and join in a discussion. Invitations to join would be sent via an email, SMS, instant messaging, phone, web browser, email or fax communication. The user would have control over whether he or she wanted to be invited into a community, the age of desired matches, the closeness or breadth of the matches, the duration of the community, and the type of community--voice or text. Also, users have the ability to a.) conduct joint searches, and b.) jointly and severally rate the content information, websites, or other subjects, and c.) to pick settings to establish his or her actual identity or to adopt an anonymous identity. (Abstract)

Importantly, Burnstein discloses reliance on **searches** and not on questionnaires. Further,

Burnstein does **not** disclose a status message confirming an accomplished act.

B. SUMMARY OF THE MUNSIL DISCLOSURE:

Munsil teaches a billing system and method. (Title) Munsil discloses a bill editor,

generator, messaging and insert system and method that comprise a portion of a bill production

processor designed to create monthly billing statements. The statements are sent to customers

which detail charges incurred over the course of a billing cycle. The bill editor and generator

allow billing personnel to design a bill using static text, dynamic text and paragraph areas. Once

the report/bill is defined, the report definition is stored in temporary memory for later use. The

report definition file defines how the report is to appear and where the data used in the report is

stored. The report generator, when subsequently run, uses the predefined report definition to

retrieve data from the database and generates the report as defined by the report definition file.

The bill messaging and insert system determines, based on assigned priority, criteria and weight

and space limitations, the messages and notices to be included in a customer billing statement.

(Abstract) Although Munsil teaches inclusion of messages on billings that it mails, the

information flow is unidirectional to the customers and it does not include questionnaires in

those messages for providing information flow from the customers to the billing entity. Further,

a status message confirming an accomplished act is not disclosed.

C. SUMMARY OF THE QUACH DISCLOSURE:

Quach teaches a front message exchange system and method. (Title) Quach enables a

first member of a group to post a public electronic message and enables the first member to

assign the message to a second member of the group for handling. (Abstract) One form of such messaging is called "podium messaging" shown in Fig. 19 wherein "a user can post an instant message for other users. The users for whom the instant message is posted may belong to one or more forums. A podium message is an instant message for all users who are currently browsing the website or are currently logged onto a system incorporating podium messaging. A system administrator may choose to allow whether a non-member [non-forum/group member] can view the podium message." (Quach, paragraph [0143])

D. SUMMARY OF THE CARTER DISCLOSURE:

Carter teaches a policy and attribute based access to a resource. (Title) Carter discloses techniques for controlling access to a resource based on access policies and attributes. A principal issues a request to a service for purposes of accessing a resource. The principal is authenticated and a service contract for the principal, the service, and the resource is generated. The service contract defines resource access policies and attributes which can be permissibly performed by the service on behalf of the principal during a session. Moreover, the session between the service and the resource is controlled by the service contract. (Abstract) Customer profile questionnaires are not disclosed. Further, a status message confirming an accomplished act is not disclosed.

E. OVERVIEW OF APPELLANT'S DISCLOSURE:

In the following discussion, all details including all usages of reference numerals and Fig. numbers are intended to be merely examples and not to be limiting in any respect. In overview, Appellant's disclosure includes information about to how to determine which

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customers, e.g., a Telco's customers, share a common interest so they can register for a

community of interest (COI) service based on that common interest. A database as depicted in

Fig. 5 is maintained by the Telco in which customer interests 508 are included. This database is

built-up in response to server 102 (depicted in Fig. 1 and detailed in Fig. 6) receiving answers to

customers' *questionnaires* which were inserted in customers' invoices or which were on-line

questionnaires. These interests 508 are associated with their respective customers, as shown in

Fig. 5. Customers having overlapping or common interests can be associated within a domain by

operation of server 102 shown in Fig. 1 and 600 shown in Fig. 6; such operation is depicted in

the flowcharts and discussed, for example, at least in paragraph [0040].

In accordance with act 208 in Fig. 2, a customer can register for a community of interest

(COI) service. Each customer in the database may perform this procedure. This is discussed in

paragraph [0031]. Each customer may go to a universal resource locator (URL) associated with

a COI flyer received in the mail to register for a respective desired service. The detail of this

registration is disclosed in Fig. 3 and in paragraphs [0032] - [0033]. This can involve an on-line

user profile questionnaire about each customer's areas of interest and other personal information.

The telco 100 COI server 102 of Fig. 1, shown in more detail in Fig. 6, and discussed in

paragraphs [0036] to [0040], receives the various completed questionnaires, establishes an

account for each such customer and sends logon information to the customer, after which the

customer can use the respective desired COI service. This, of course, is done with respect to

each customer who responds in this fashion.

In Fig. 4, per act 402, server 102 can receive an inquiry from a particular customer with

respect to the area of interest selected by that particular customer. This request is processed per

Fig. 4, as discussed in paragraph [0034]. For example, in act 410, server 102 selects other

customers in its database with criteria that match the particular customer's profile to form a

group of customers with common interest, and maps the above-noted database entries to aliases of the matching customers. In act 412, a *status message* is sent to the inquiring customer and to other customers having interest in common with each other and with the inquiring customer to confirm that the inquiring customer has joined the group. Importantly, and as claimed, the status message also may *only* be sent to those persons already associated with the COI to let them know that a new member has joined the group. (Appellant's specification, ¶ [0034]) Stored in the database are aliases (512, Fig. 5) of customers in this particular group having common interest; these aliases include the alias for the inquiring customer. The aliases are distributed amongst the group by the server, thereby allowing group members to communicate with each other on an anonymous basis.

The detail of the database of Fig. 5 is discussed in paragraph [0035]. The server is depicted in Fig. 6 and is discussed in paragraphs [0036] - [0040]. In addition, a screenshot is depicted in Fig. 7 showing what an inquiring customer may see when attempting to join a COI group in this manner. Description of customer interaction with the screenshot is presented in paragraphs [0041] - [0044].

F. THE LAW

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). KSR International Co. v. Teleflex Inc., 550 U.S. _____ (April

30, 2007).

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)

A prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

The MPEP requires that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added).

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir., 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

MPEP 2143.01 The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)

MPEP2143.02(I) The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

MPEP2143.02(II) Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of non-obviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976)

In re Oetiker further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). "The Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998) (emphasis added). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references"); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)

("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination"); *accord* MPEP § 2143.

The courts have consistently held that that "there must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references". *In re Stemniski*, 444 F.2d 581 (CCPA 1971). Obviousness cannot be established by combining pieces of prior art absent some "teaching, suggestion, or incentive supporting the combination". *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). And "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

In *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, (April 30, 2007), the Supreme Court did not disturb the well-settled proposition that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention, as the Federal Circuit stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Further, the USPTO has published Section 103 Examination Guidelines that are consistent with this requirement of *Gore*. *See* Section 103 Examination Guidelines, 72 F.R. 57526 (October 10, 2007). Additionally, the Court made clear that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known and in the prior art." *KSR* at 14.

Further, an Examiner cannot simply ignore conflicting portions of two or more references when the Examiner has alleged that the references can be combined. MPEP § 2143.01 states that

"[w]here the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another."

It is established law that one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Based on these legal principles, Appellant submits that the pending claims are allowable at least because (1) questionnaires are not taught by any of the cited references taken individually or in any reasonable combination and (2) status messages sent only to community of interest (COI) members, excluding the newly-joining member(s), confirming that new customer(s) have joined a COI are not taught by any of the cited references and Official Notice taken individually or in any reasonable combination, as explained below.

G. INDEPENDENT CLAIM 1:

(i) sending...a generated status message to *only* said other customers...as confirmation that said one customer has joined said COI

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In <u>Grounds of Rejection Number One</u>, claim 1 is rejected under 35 U.S.C. § 103(a) as

allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach and

further in view of Official Notice. Claim 1 recites, *inter alia*:

> "<u>sending</u>, by operation of said computer, <u>a generated status message to *only* said other customers, if said COI exists, as confirmation that said one customer has joined said COI</u>." (emphasis added)

The Office Action admits "Burnstein fails to expressly disclose generating and sending a status

message to *only* said certain customers as confirmation that said at least one inquiring customer

has joined said COI." (Office Action, ¶ 14, pg 5, emphasis in original) Appellant submits that

Burnstein not only fails to expressly disclose that status message, but fails, <u>without qualification</u>,

to disclose that status message (discussed in detail in section I(v), pg 39 hereinbelow).

The Examiner then relies upon Quach and newly-applied Official Notice to make up for

this admitted deficiency of Burnstein: "However, Quach discloses generating a message to

current members [this includes the new member] regarding a new member to a community/group

(Para 0143-0144, Fig. 13A) and Official Notice is taken that it would have been obvious to one

of ordinary skill in the art at the time the invention was made that the new user would not need to

receive the message - as they would already be aware that they joined the group."[3] (Office

Action, ¶14, pg 5) Appellant respectfully disagrees with the application of Quach in

combination with this Official Notice against claim 1 for reasons presented below.

Furthermore, even if such Official Notice were valid and combinable with Quach, which

it isn't for reasons given below, there still would be a major deficiency in the

Burnstein/Quach/Official Notice combination relative to Appellant's claim 1. The Official

Notice attempts to address only the deficiency in Quache resulting from its inclusion of the *new*

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[3] Munsil, cited for disclosing the tracking of customer billing information and account information, is irrelevant to the status message issue.

member in its welcoming emails. But, there is a _further_ teaching (deficiency) in Quach that non-members are also notified when a new member joins, and this further teaching (deficiency) prevents the Burnstein/Quach/Official Notice combination from making obvious the subject matter of Appellant's claim 1 in the first place.

Consider Quach paragraph [0143], also cited by the Examiner (Office Action, pg 5, ¶ 14) which provides:

> [0143] FIG. 19 is a screen shot of an exemplary embodiment user-interface 210 for podium messaging. Using podium messaging, a user can post an instant message for other users. The users for whom the instant message is posted may belong to one or more forums. A podium message is an instant message for all users who are currently browsing the website or are currently logged onto a system incorporating podium messaging. **A system administrator may _choose_ to allow whether a _non-member_ can view the podium message.** (emphasis added)

Quach paragraph [0143] clearly says that a system administrator may _choose_ to allow non-members of the group to view the podium message. Thus, Quach teaches that its welcoming announcement, made by way of its podium messaging technique, not only is directed to group members, but is also directed to non-group members under a system administrator's discretion. Indeed, as the system administrator allows non-members to view the podium message, as taught by Quache, the podium message is not sent to only the members (customers).[4] Therefore, the Burnstein, Quache, Official Notice and Munsil combination does not disclose or suggest: "sending, by operation of said computer, a generated status message _to only said other customers_, if said COI exists, as confirmation that said one customer has joined said COI" as recited in claim 1. (emphasis added)

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[4] This had previously been explained in a previous response filed by Appellant (Applicant) on March 9, 2010: "In sum, Quach teaches that a welcoming member sends an instant message about the newest member who has joined the site last to ALL members which necessarily includes that newest member (not to mention the fact that Quach also sends the message to non-members via the system administrator). Applicant's claim 1 clearly avoids Quach because (1) the claim excludes the newest member from receiving that status message and (2) the claim excludes non-members from receiving that status message while Quach teaches the opposite." (Remarks, March 9, 2010, pgs 13-14) Item (1) was responded to by the Examiner with the alleged Official Notice discussed herein, but item (2) was not answered by the Examiner in the final Office Action nor in the subsequent Advisory Action.

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967). That factual basis has not been provided herein.

Thus, a prima facie case of obviousness has not been established. For this reason alone, the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.

(ii) Official Notice invalid

Furthermore, Appellant contends the alleged Official Notice taken is not valid or effective. The only confirmation that the customer has joined the COI, expressly recited in claim 1, is the recited status message. There is nothing else recited in the claim that expressly confirms that the customer has joined the group. Although the one customer and the other customers in "said subset comprising said one customer and said other customers" as recited in claim 1 communicate "with each other using said domain" as recited in claim 1, that language, by itself, is not confirmation of a legitimate entry into (joining) a particular group in every instance. Hackers do exist in the world. Someone might gain entry to that domain and to that COI group by a nefarious pathway. Thus, contrary to the alleged Official Notice, mere participation by a new party with the group does not necessarily provide the new party with a status message equivalent confirming acceptance of that new party. Accordingly, the alleged Official Notice that such new party knows he/she "has joined" (as recited in claim 1) the group, merely because that party is participating, is not "capable of such instant and unquestionable demonstration as to defy dispute" (see: MPEP 2144.03A)

Therefore, Appellant had traversed the Examiner's Official Notice and, per 37 C.F.R. 1.104(d)(2), and had requested an affidavit from the Examiner to prove that mere participation

with the group inherently means awareness of actually joining the group in every instance, particularly if such participation was achieved by other than an authorized entry to the group. (See Appellant's Remarks, filed August 3, 2010, pg 15) The Examiner has not provided that affidavit and has not addressed this Official Notice issue in the Advisory Action. Appellant submits that such complete non-response implies acquiescence, particularly when official notice in final rejections, as here, should be "rare" (MPEP 2144.03(A)). Thus, the rejection of claim 1 has been overcome on the basis of this Official Notice argument alone. For this additional reason, the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.

(iii) Official Notice Not Combinable with Quach

In addition, Appellant further contends that the alleged Official Notice taken is not combinable with Quach in the first place. Quach is directed to acquiring, and/or welcoming, gay membership. As such, it does not lend itself to being combined with any reference (defacto or official notice) suppressing communication - such as official notice which allegedly teaches that a status message can be withheld from anyone including a new gay member. To the contrary, Quach supports increasing and encouraging membership in any way it can by spreading the word. For example, Quach says: "Be a friendly neighbor and help welcome Craigay2000 in 585 area who joined us on 5/5/2003." (Quach, Fig. 13A screenshot and paragraph [0127]) This paragraph describes this screenshot as representative of "casual messages" which can be overheard by other community users who do not even have to be online, the screenshot offering a "gossip" link to promulgate the message as much as possible. In other words, this casual message asks all members to whom it is directed, and anyone else who receives it, to send a message to the new gay member to welcome him to the group. In this case, the new member may receive multiple welcoming messages (alleged "status" messages) from multiple group members.

Moreover, this solicitation for the welcoming message, or a similar solicitation, appears in no fewer than twenty-four (24) screen-shot Figs. in Quach, namely: Figs. 7A-7G, 8, 10D, 10F, 11A-11C, 12A-12B, 13A-13E, 14-17 and 19! Appellant submits that the appearance of this solicitation in so many Figs. of Quach reinforces Appellant's position that a fundamental purpose of Quach is to reach out and welcome the new gay man to its group with this "status" message. Thus, the Examiner's alleged Official Notice that suggests not sending such welcome message to the new member (because the new member allegedly knows he is a new member) simply is teaching opposite to what Quach is all about and teaches away from Quach, wherefore Quach and this particular Official Notice are not combinable in the first instance.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Considering Quach in its entirety, it leads away from alleged Official Notice.

Further, an Examiner cannot simply ignore conflicting portions of two or more references when the Examiner has alleged that the references can be combined. MPEP § 2143.01 states that "[w]here the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another." The Examiner alleges that Quach and the specified Official Notice can be combined, but the conflicting notions are being ignored, and this isn't permitted.

For this additional reason, the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.[5]

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[5] Not to mention the fact that, in addition to the alleged Official Notice being completely opposite from the teaching with which it is being combined, the taking of any official notice in final office actions, as in this instance, is supposed to be a "rare" event. See MPEP 2144.03A: "While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection..."

(iv) providing said each of said plurality of customers with a customer profile *questionnaire*

Claim 1 recites, inter alia: "providing said each of said plurality [of customers] with a customer profile questionnaire." The Examiner applies Burnstein against this claim element. (Office Action, pg 4) Therein, when referring to Burnstein, Figs. 6-10, it says *"providing search ability and receiving search string information is equivalent to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users."* (italics in original) Appellant respectfully disagrees because Burnstein does not disclose a questionnaire. Regardless of Burnstein's alleged "advancement" on the subject of collecting profile information, the activity of receiving data to correlate users because Burnstein's receiver of that data (the search service/engine) wants to correlate users is not equivalent to receiving data to correlate users because Appellant's supplier of that data (the customer who voluntarily completes a questionnaire and wants to join) wants to correlate users. To repeat for emphasis, because this is an important distinction: Burnstein's data *receiver* system desiring user correlation is quite different from Appellant's data *supplier* customer desiring user correlation.

Burnstein says: "After making a match the invention automatically invites the matched parties to join a frictionless and immediate electronic community *if they so desire.*" (Burnstein, paragraph 13; emphasis added) Thus, a received search string in Burnstein carries with it a question about the formation of an electronic community. For example, this could be a question about whether this search string is acceptable subject matter for discussion within the electronic community but, quite differently, information supplied in response to Appellant's questionnaire is always acceptable since it is *pre-approved* by the information-supplier for community discussion because that is why it is being supplied in the first place.

In other words, in Burnstein, after a search request is made, the searching party receives,

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and possibly is surprised and/or even annoyed, with an invitation to join a group whose members have also, for whatever reasons, searched the same topic. The searching party may refuse to join. Not every searched-subject is a candidate for discussion for every searching party. Some subjects may be very private/sensitive to some individuals under certain circumstances. For example, someone searching his/her personal phobias or addictions may not want to join-in a group discussion about them. For another example, someone searching his/her proprietary or trade secret subject matter, which must be kept confidential, may not want to join in a group discussion. This is quite different from receiving a blank questionnaire, as Appellant discusses, to be _voluntarily_ answered by a party who knows in advance that he/she is attempting to join a discussion group about the subject being entered into the questionnaire – and who wants to discuss that subject. Common search data does not necessarily imply a mutual interest in the various parties submitting that common data to discuss it. That is why Burnstein offers the option of not joining a COI: i.e., "if they so desire" as noted above.

Indeed, Appellant's questionnaire, which is to be affirmatively completed _only_ if the participant wants to participate in a discussion of a particular subject noted in the questionnaire, is quite different, _ab initio_, from a search request. Therefore, contrary to the Examiner's interpretation, Burnstein's teaching of search ability is not equivalent to Appellant's teaching of sending a questionnaire regardless of Burnstein's alleged advance over questionnaires. [6]

Moreover, Burnstein itself suggests that operation of its disclosed invention is different from using a questionnaire. Referring to its paragraphs [0049] and [0050]: "However, one of the weaknesses of these existing systems is that they require users to either (1) enter a pre-defined gathering space or _answer questions_ or (2) create a pre-determined profile." (Burnstein

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[6] Consider an analogy based on an airplane and an automobile, in terms of this issue. One would consider an airplane to be an advance over an automobile in terms of transportation efficiency, speed, passenger miles, etc., but that advance, by itself, does not imbue an airplane with capacity to read on a claim expressly directed to a car.

paragraph [0049], emphasis added) "Further, it [the Burnstein patent] provides a means and method of comparing that search with prior search terms entered by others to make a match between similar searches - *without needing to predetermine the basis for the match*." (Burnstein paragraph [0050], emphasis added).

Thus, Burnstein's view is that answering questions and predetermining the basis for the match is an alleged weakness of existing systems which Burnstein asserts has been overcome by resorting to something quite different, common search strings. Therefore, Burnstein essentially admits that it doesn't "answer questions" reinforcing Appellant's position that it does not read on "providing each of said plurality of customers with a customer profile questionnaire" as recited in claim 1. Further, Appellant submits that Burnstein's disclosed view that it has overcome a perceived weakness to "answer questions" is devoid of detail and does not read on "providing said each of said plurality [of customers] with a customer profile questionnaire" as recited in claim 1.

In addition, Appellant submits that people ordinarily do not search all subjects in which they have interest. A search of a particular subject is conducted for a particular reason and a search string is focused on a specific topic. Therefore a large segment of subject matter of interest to an individual shall probably remain unsearched, undisclosed and not inquired about, in accordance with the teachings of Burnstein, when using only that individual's current search string as the basis for inquiring about his/her interest in joining a community of interest (COI).

By contrast, when presenting a questionnaire, in accordance with Appellant's disclosure, a wide-ranging inquiry about subject matter of interest can be presented to that individual who is not restricted in his/her response. Thus, subjects in a wide spectrum and unrelated to each other can emerge responsive to open-ended questions in a questionnaire, as compared to a mere subset of those subjects, if not only one subject, that would be submitted for a search. Accordingly,

Appellant can offer a basis for chatting with others on virtually all non-private subjects of current interest to that individual while Burnstein does not. This example underscores the fact that the search string information and the questionnaire responses *are not equivalent* mechanisms for setting up communities of interest for conversation or interaction, and that questionnaires have advantages over search strings in this regard.

Because a customer profile questionnaire is not provided by Burnstein for reasons given above, other limitations of claim 1, namely, "receiving responses to said *questionnaire* from at least a portion of said plurality of customers" and "allowing at least a subset of said portion of said plurality of customers giving common answers to said *questionnaire*" are not disclosed or suggested by Burnstein taken alone or in any reasonable combination with the other cited references. (emphases added) Neither Munsil, cited against claim 1 to show billing statements, nor Quach (with or without Official Notice), cited against claim 1 to show a generated status message confirming the joining of a group, nor Carter, cited against claims other than claim 1 to show randomly-generated alias names, taken individually or in combination, cure this deficiency in Burnstein. For this additional reason, the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.

Thus, for any one or all of the reasons given above, a prima facie case of obviousness has not been established and the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.

Dependent claims 2-7 and 18 are likewise allowable, at least for reasons based on their respective dependencies from allowable base claim 1.

H. INDEPENDENT CLAIM 9:

In <u>Grounds of Rejection Number One</u>, claim 9 is also rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach and further in view of Official Notice. Claim 9 recites, *inter alia*:

> "notification means associated with said billing means for informing said each of said plurality about said domain and for providing said each of said plurality with a customer profile *questionnaire*; means for receiving responses to said *questionnaire* from at least a portion of said plurality and for allowing at least a subset of said portion of said plurality giving common answers to said *questionnaire* to communicate with each other using said domain, wherein said receiving and allowing means includes means for receiving an inquiry about a community of interest (COI) from one customer of said subset, means for determining existence of said COI with other customers of said subset belonging to said COI, and <u>means for sending a generated status message to *only* said other customers as confirmation that said one customer has joined said COI</u>" (claim 9; emphasis added)

Clearly, claim 9 recites a customer profile <u>questionnaire</u> as well as sending a generated status message to <u>only</u> the other customers as confirmation that the one customer has joined the community of interest. Accordingly, all arguments made above for allowability of claim 1 relating to the recited "questionnaire" and the constrained "status message" are directly applicable to claim 9. Further, all arguments against combining specified Official Notice with Quach made above are directly applicable in this rejection of claim 9. All such arguments are incorporated herein by reference. Appellant respectfully submits that claim 9 is allowable for reasons that are the same as, or similar to, those reasons given above for allowability of claim 1. The 35 U.S.C. §103(a) rejection of claim 9 should be REVERSED and the claim allowed.

Thus, for any one or all of the reasons given above, a prima facie case of obviousness has not been established and the 35 U.S.C. §103(a) rejection of claim 1 should be REVERSED and the claim allowed.

Dependent claim 10 is allowable at least for reasons based on its dependency from allowable base claim 9.

I. INDEPENDENT CLAIM 11:

In <u>Ground of Rejection Number Two</u> claims 11 and 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burnstein in view of Quach and Official Notice. (Office Action, pgs 7-9, where the Official Notice aspect of the rejection is expressed in paragraph 28 on page 9 of the Office Action)

The Office Action applies Burnstein against recited elements of claim 11 that are similar to recited elements of claim 1 in the same manner as it was applied in claim 1. For example, compare the bottom of page 7 of the Office Action wherein Burnstein's "Figs. 6-10, providing search ability..." etc. is applied to Appellant's "providing" and "receiving" steps in claim 11 with the top of page 4 of the Office Action wherein Burnstein's "*Figs. 6-10, providing search ability...*" etc. (italics in original) is applied to Appellant's "providing" and "receiving" steps in claim 1.

Further, the Office Action applies Quach and Official Notice against recited elements of claim 11 that are similar to recited elements of claim 1 in the same manner as Quach and Official Notice were applied in claim 1. For example, compare paragraphs 27-29 of the Office Action (pgs 8-9) discussing claim 11 with paragraphs 13-15 of the Office Action (pgs 5-6) discussing claim 1. The two sets of paragraphs are virtually identical; in paragraph 27 the Examiner apparently inadvertently omitted "only." Therefore, the argument given above for allowability of claim 1 is directly applicable to claim 11 and is incorporated herein by reference.

In further detail, claim 11 is directed to a method which recites, *inter alia*:

"providing each of said plurality of customers with a customer profile *questionnaire*; receiving responses to said *questionnaire* from at least a portion of said plurality of customers; allowing a subset of said portion of said plurality of customers giving common answers to said *questionnaire* to have access to a domain associated with said service provider; accepting data from at least one of said subset of said portion of said plurality of customers, verifying a true identity of said at least one of said subset of said portion of said plurality of customers based upon at least a portion of said data;

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mapping said true identity to an alias associated with said at least one of said subset of said portion of said plurality of customers; and allowing others of said subset of said portion of said plurality of customers with access to said domain to have access only to said alias while keeping said true identity in confidence; wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, <u>and a status message is generated and sent to <i>only</i> said certain customers as confirmation that said at least one inquiring customer has joined said COI</u>." (claim 11, emphasis added)

Clearly, claim 11 recites a customer profile questionnaire as well as sending a generated status message to only said certain customers as confirmation that the one inquiring customer has joined the community of interest. Accordingly, the arguments set forth above for allowability of claim 1 relating to the recited "questionnaire" and the constrained "status message" are directly applicable to claim 11. Further, Appellant's arguments made above against Official Notice and against combining Official Notice with Quach are directly applicable in this rejection. All of those arguments are incorporated by reference herein. Appellant respectfully submits that claim 11 is allowable for reasons that are the same as, or similar to, all reasons given above for allowability of claim 1. The 35 U.S.C. §103(a) rejection of claim 11 should be REVERSED and the claim allowed.

(v) Burnstein does not teach ANY status message - misinterpretation of Burnstein's paragraph [0016] - Burnstein and Quach cannot be combined

In addition, the Office Action mis-interprets Burnstein in its application of Burnstein's paragraph [0016] as reflecting Appellant's status message: "(Para 0016, system automatically asks permission of current user to make match - equivalent to status message)." (Office Action, pg 8) Appellant respectfully disagrees. Burnstein, paragraph 16 says:

[0016] The problem is that there typically needs to be a critical mass of 5-500 users to provide enough people to cover a wide range of questions that might be asked on any given topic. This invention only requires that there be as little as two people who have a similar interest. <u>Even if the earlier searcher is not currently looking for information on this subject this invention "remembers" his or her [previously-expressed] interest and automatically asks permission [of the earlier searcher] to make a match with someone who is interested.</u>

(Burnstein, paragraph 16, emphasis added) This section of Burnstein says that even if a previous searcher (the "earlier" searcher) is not currently searching, the topic that was previously searched by the previous searcher is remembered by the Burnstein system and if another searcher ("someone who _is_ interested") should subsequently search the same topic, or a similar topic, the previous searcher is _asked_ permission to make a match with the current searcher. Erroneously, the Office Action states: "Para 0016, system automatically asks permission of _current user_ to make match - equivalent to status message." (Office Action, page 8; emphasis added) Appellant respectfully, but emphatically, disagrees for several reasons including the fact that permission is being asked of a former user, not of the current user.

Indeed, the Examiner mis-interprets to whom the query is being directed. The system does not automatically ask permission of the _current user_. The query is actually being directed to the _previous_ searcher, not the current searcher. The above quoted passage in Burnstein says "asks permission to make a match with someone who _is_ interested." The previous searcher _was_ interested at the time the previous searcher made his/her search, but it isn't known if the previous searcher still is interested. If the previous searcher is not currently searching that topic, a possibility which the passage suggests, then the only party who _is_ interested for certain is the _current_ searcher. Logically, therefore, permission must be asked of the _previous_ searcher in order to make a match with someone who _is_ interested, namely, the current searcher.

Arguendo, even if one takes the Examiner's position (with which Appellant disagrees) which is that a current searcher is being asked to join with a previous searcher who has been dormant relative to searching this topic (and this is opposite to the teaching in Burnstein), the activity of _asking_ permission of anyone to make a _future_ match is not confirmation of a previous match, in any event. Appellant's recited limitation is:

wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, and a status message is generated and sent to only said certain customers as confirmation that said at least one inquiring customer *has joined* said COI." (claim 11, emphasis added)

Clearly, Appellant's recited limitation calls for "confirmation that said at least one inquiring customer *has joined* said COI" (emphasis added) and this is a status message that provided confirmation of a deed that has taken place. This is a status message confirmation of a past-accomplished deed. Note the usage of past tense in the term **"has joined"** which is recited in the claim. The MPEP requires that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added). The Examiner is apparently ignoring these words.

But, quite differently, the passage in Burnstein interpreted by the Examiner to suggest a status message, namely, "asks permission [of the earlier searcher who had previously expressed interest] to make a match with someone who is interested [the current searcher]" clearly refers to a match that might take place in the future. Perhaps, the current searcher who is interested shall eventually join and perhaps not. For example, suppose the "earlier searcher" in Burnstein's paragraph [0016] refuses permission to join for whatever reason. In the case of only "two people" as disclosed in Burnstein's paragraph [0016], the current searcher who is interested can't join a non-existent group and, therefore, shall not have joined. Indeed, to ask permission of "the earlier searcher" (or even ask permission of multiple earlier searchers if there are multiple earlier searchers) to make a match with "someone [else] who *is* interested" (Burnstein, ¶ 16; emphasis added) is merely making a request to join, and is certainly *not* a confirmation of a deed that had previously taken place. It is not a "confirmation that said at least one inquiring customer has

joined said COI" as recited in claim 11. The fundamental weakness in the Examiner's position

is: **asking is not confirming**.

Because <u>asking permission to join is not a confirmation that the customer has joined</u>, Burnstein does not disclose or suggest ANY status message, much less Appellant's recited confirming "status message" contrary to the Examiner's assertion in the Office Action. Thus, although the Examiner says that "Quach discloses generating a message to current members regarding a new member to a community/group (Para 0143-0144, Fig. 13A)" (Office Action, pg 9) and attempts to combine Quach with Burnstein in this rejection of claim 11 because Burnstein allegedly teaches sending a confirming status message (which it clearly does not), that combination of references cannot be made. Appellant has shown above that Burnstein does not send a confirming status message but, instead, merely asks a previous searcher if a new searcher can join.

Thus, there is insufficient nexus to combine Quach with Burnstein in the first place. Burnstein does <u>not</u> teach sending a confirming status message at all, while Quach sends emails to <u>everyone</u>, including the new member, about the new member (wherefore the Examiner needed to rely upon Official Notice which Appellant has shown is invalid). Appellant submits that there is insufficient motivation to be derived from either reference, Quach or Burnstein, to combine itself with the other.

Further, the KSR reference in the Office Action: "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results" is inapplicable because the combination of one reference (Burnstein) that does not show a confirming status message with another reference (Quach) that arguably shows a plurality of confirming status messages does not yield predictable results. In addition, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ____, (April 30, 2007), the Supreme Court did not disturb the well-

settled proposition that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention, as the Federal Circuit stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Considering these two references in their respective entireties, it is clear that they lead away from each other.

The 35 U.S.C § 103(a) rejection of claim 11 should be REVERSED and the claim allowed for these additional reasons alone.

Dependent claim 12-15 are allowable at least for reasons based on their respective dependencies from allowable base claim 11.

J. INDEPENDENT CLAIM 17:

In Ground of Rejection Number Three claims 10 and 17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Burnstein in view of Munsil, in view of Quach, in view of Carter, and further in view of Official Notice. (Office Action, pgs 10-14, where the Official Notice aspect of the rejection is expressed in ¶ 43on page 13 of the Office Action)

The Office Action applies Burnstein against recited elements of claim 17 that are similar to recited elements of claim 1 in the same manner as Burnstein was applied in claim 1. For example, compare the middle of page 11 of the Office Action wherein Burnstein's "Figs. 6-10, providing search ability…" etc. is applied to Appellant's "providing" and "receiving" steps in claim 17 with the top of page 4 of the Office Action wherein Burnstein's "*Figs. 6-10, providing search ability…*" etc. (italics in original) is applied to Appellant's "providing" and "receiving" steps in claim 1.

Further, the Office Action applies Quach and Official Notice against recited elements of claim 17 that are similar to recited elements of claim 1 in the same manner as Quach and Official

Notice were applied in claim 1. For example, compare paragraphs 42-44 of the Office Action (pg 13) discussing claim 17 with paragraphs 13-15 of the Office Action (pgs 5-6) discussing claim 1. The two sets of paragraphs are essentially the same (although in ¶ 42 the Examiner omitted "only" and uses language that doesn't track language of claim 17). Therefore, the analysis given above for claim 1 is applicable to claim 17. Munsil is cited only for disclosing tracking customer billing information and account information (Office Action, pg 12, paragraph 40) and is otherwise irrelevant to this discussion and does not cure any deficiencies of the other references noted herein. Carter is cited only for disclosing "randomly generating alias identity information for community users (Para 0039)" (Office Action, pg 14, paragraph 46) and is otherwise irrelevant to this discussion and does not cure any deficiencies of the other references noted herein.

In further detail, claim 17 is directed to a method which recites, *inter alia*:

> "notifying said each customer by way of its respective billing statement from said service provider about a common domain in said network over which anonymous communication may take place and providing said each customer with a customer profile *questionnaire*; receiving responses to said *questionnaire* from at least a portion of said plurality of customers; providing a subset of said portion of said plurality of customers giving common answers to said *questionnaire* with access to said domain and giving each in said subset access to information about said interests of said other customers in said subset to permit said anonymous communication between said each customer in said subset and said other customers in said subset, said anonymous communication resulting from aliases each generated randomly by a server for, respectively, a different one of said subset of customers, whereby said each customer in said subset knows said aliases and not true identities of said other customers in said subset; permitting each in said subset to inquire about a respective community of interest (COI); determining existence or non-existence of said COI; sending, by operation of said computer, if said COI exists, a generated status message *only* to others of said subset who belong to said COI as confirmation that said inquiring customer has joined said COI; and sending, if said COI does not exist, a different generated status message to said inquiring customer signifying that said inquiring customer has successfully joined a new COI." (claim 17, emphasis added)

Clearly, claim 17 recites a customer profile questionnaire as well as sending a generated status message only to others of the subset who belong to the COI as confirmation that the inquiring customer has joined the community of interest. Accordingly, the arguments set forth above for allowability of claim 1 relating to the recited "questionnaire" and the constrained "status message" are directly applicable to claim 17. Further, the arguments made with respect to allowability of claim 1 against Official Notice and against combining Official Notice with Quach are also directly applicable here. All of those arguments are incorporated by reference herein. Appellant respectfully submits that claim 17 is allowable for reasons that are the same as, or similar to, all reasons given above for allowability of claim 1. The 35 U.S.C. §103(a) rejection of claim 17 should be REVERSED and the claim allowed.

In addition, with respect to claim 17, the Office Action again mis-interprets Burnstein in its application of Burnstein's paragraph [0016] as allegedly reflecting Appellant's status message: "(Para 0016, system automatically asks permission of current user to make match - equivalent to status message)." (Office Action, pg 12) Appellant respectfully disagrees for all of the reasons given above with respect to this argument in connection with allowability of claim 11. Appellant respectfully submits that claim 17 is also allowable for reasons that are the same as, or similar to, all reasons given above in this regard for allowability of claim 11. The 35 U.S.C. §103(a) rejection of claim 17 should be REVERSED and the claim allowed for this additional reason.

CONCLUSION

Appellant respectfully requests that the Honorable Board REVERSE the final rejection of the appealed claims for the reasons given above.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. **07-2347** and please credit any excess fees to such deposit account.

Respectfully submitted,

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VIII: CLAIMS APPENDIX

1.   A computer-implemented method for connecting no more than a plurality of customers

using a domain accessible through a communications network, each of said plurality having a

billing address and an account associated with a service provider, said service provider

communicatively linked to said domain, said method comprising:

notifying said each of said plurality about said domain by including information in a

billing statement for said each of said plurality;

providing said each of said plurality with access to said domain;

providing said each of said plurality with a customer profile questionnaire;

receiving responses to said questionnaire from at least a portion of said plurality of

customers;

receiving an inquiry about a community of interest (COI) from one customer in said

portion;

determining existence of said COI with which other customers in said portion are

associated;

sending by operation of said computer a generated status message to only said other

customers, if said COI exists, as confirmation that said one customer has joined said COI; and

allowing at least a subset of said portion of said plurality of customers giving common

answers to said questionnaire, to communicate with each other using said domain while not

disclosing true identity of each customer of said subset to others of said plurality, said subset

comprising said one customer and said other customers.

2.   The method of claim 1 wherein said notifying further includes mailing said billing

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statement to each of said plurality.

3.   The method of claim 2 wherein said notifying further includes providing said plurality with a universal resource locator (URL), said URL for allowing said plurality access to said domain.

4.   The method of claim 1 wherein said access means includes a server associated with a URL and made available to said plurality of customers, said server facilitating access to said domain by said plurality.

5.   The method of claim 1 wherein said addresses are used in establishing said subset of said plurality.

6.   The method of claim 1 wherein said domain is only accessible to those of said plurality sharing a common interest.

7.   The method of claim 6 wherein said providing further requires that said each of said plurality enter a password to gain access to said domain.

9.   A system for allowing no more than a plurality of customers to communicate over a network, said system comprising:

          a service provider having an account with each of said plurality;

          a domain associated with said service provider;

          billing means controlled by said service provider for invoicing each said account;

notification means associated with said billing means for informing said each of said

plurality about said domain and for providing said each of said plurality with a customer profile

questionnaire;

means for receiving responses to said questionnaire from at least a portion of said

plurality and for allowing at least a subset of said portion of said plurality giving common

answers to said questionnaire to communicate with each other using said domain, wherein said

receiving and allowing means includes means for receiving an inquiry about a community of

interest (COI) from one customer of said subset, means for determining existence of said COI

with other customers of said subset belonging to said COI, and means for sending a generated

status message to only said other customers as confirmation that said one customer has joined

said COI; and

a server associated with said domain for allowing said each of said subset to access said

domain upon authentication.

10. The system of claim 9 wherein said server further comprises:

authentication means for allowing each of said one customer and said other customers of

said subset to establish its respective identity; and

associating means for mapping each said respective identity to an alias randomly-

generated and chosen by said server and associated with its respective customer of said subset,

said alias being made available to all other customers of said subset having access to said

domain, said alias further concealing true identity of said respective customer of said subset;

storage means for archiving said domain and information about said one customer of said

subset and said other customers of said subset having access to said domain; and

interaction means for allowing said other customers of said subset having access to said

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domain to communicate with each other and with said one customer of said subset using their respective aliases.

11.   A computer-readable medium containing a plurality of instructions that, when executed by at least one processor, causes said at least one processor to perform a method for inter-connecting through a communications network no more than a plurality of customers who are associated with a service provider, said method comprising:

providing each of said plurality of customers with a customer profile questionnaire;

receiving responses to said questionnaire from at least a portion of said plurality of customers;

allowing a subset of said portion of said plurality of customers giving common answers to said questionnaire to have access to a domain associated with said service provider;

accepting data from at least one of said subset of said portion of said plurality of customers,

verifying a true identity of said at least one of said subset of said portion of said plurality of customers based upon at least a portion of said data;

mapping said true identity to an alias associated with said at least one of said subset of said portion of said plurality of customers; and

allowing others of said subset of said portion of said plurality of customers with access to said domain to have access only to said alias while keeping said true identity in confidence;

wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, and a status message is generated and sent to only said certain customers as confirmation that said at least one inquiring customer has joined said COI.

12.   The method of claim 11 further comprising:

notifying said plurality of customers about said domain by including information in a

billing statement associated with said service provider.

13.   The method of claim 11 further including storing said domain and information about

those of said plurality of customers having access to said domain.

14.   The method of claim 11 wherein said allowing said domain access and said allowing said

alias access include a server coupled to said communications network.

15.   The method of claim 14 wherein said at least one of said plurality of customers uses a

web browser to access said domain.

17.   A computer implemented method for enabling each customer in a plurality of customers

of a service provider to determine if other customers in said plurality have one or more interests

in common with said each customer and to anonymously communicate over a network with

certain of said other customers having said interests in common, said method comprising:

notifying said each customer by way of its respective billing statement from said service

provider about a common domain in said network over which anonymous communication may

take place and providing said each customer with a customer profile questionnaire;

receiving responses to said questionnaire from at least a portion of said plurality of

customers;

providing a subset of said portion of said plurality of customers giving common answers

to said questionnaire with access to said domain and giving each in said subset access to

information about said interests of said other customers in said subset to permit said anonymous communication between said each customer in said subset and said other customers in said subset, said anonymous communication resulting from aliases each generated randomly by a server for, respectively, a different one of said subset of customers, whereby said each customer in said subset knows said aliases and not true identities of said other customers in said subset;

permitting each in said subset to inquire about a respective community of interest (COI);

determining existence or non-existence of said COI;

sending, by operation of said computer, if said COI exists, a generated status message only to others of said subset who belong to said COI as confirmation that said inquiring customer has joined said COI; and

sending, by operation of said computer, if said COI does not exist, a different generated status message to said inquiring customer signifying that said inquiring customer has successfully joined a new COI.

18.   The method of claim 1 further comprising:

sending a generated status message to said one customer, if said COI does not exist, as confirmation that said customer has successfully joined a new COI.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None